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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,089	01/18/2006	Andreas Schmidt	P33653US	5419
81722	7590	10/13/2009		
Viering, Jentschura & Partner 3770 Highland Ave. Suite 203 Manhattan Beach, CA 90266			EXAMINER	
			HUYNH, NAM TRUNG	
			ART UNIT	PAPER NUMBER
			2617	
			NOTIFICATION DATE	DELIVERY MODE
			10/13/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

vjp-us@vjp.de  
patint@vjp.de

### Office Action Summary

**Application No.**

10/565,089

**Applicant(s)**

SCHMIDT ET AL.

**Examiner**

NAM HUYNH

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18, 19 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 19 and 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 18, 19, 21-29, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Souissi et al. (US 7,392,039).

Regarding claim 18, Souissi teaches a method for transmitting a useful data object (message) from a switching component to a mobile station (column 3, lines 39-42), comprising:

the mobile station selecting, with the aid of a selection device (user input providing instructions to either obtain the complete message or not to obtain the complete message), the selection device being assigned to the mobile station (user input device is resident to the mobile communication device), and storing in a storage

unit assigned to the mobile station at least one communication network in which the useful data object is to be transmitted (column 4, lines 56-64; column 5, lines 32-42; The home network comprises an information server which further comprises a database that stores the message control module. The message control module knows whether the communication device is registered to the home network or another network based on the last registration, which shows that at least one communication for which the message is to be transmitted is stored); and

transmitting the useful data object from the switching component to the mobile station (download of the complete message) when it is determined that the mobile station is registered in the at least one selected communication network (the communication device is registered in the home network), and it is determined that the switching component has a delivery request for the useful data object (communication device sends message request) (column 7, lines 58-67; column 8, lines 1-3).

Regarding claim 19, Souissi teaches the mobile station is notified (notification message) by the switching component when the switching component has a useful data object for the mobile station (column 6, lines 15-27).

Regarding claim 21, Souissi teaches the at least one communication network is selected as a function of at least one parameter, the parameter comprises one of cost of transmitting the useful data object, transmission time for the useful data object, size of the useful data object, the sender of the useful data object, and the nature of the useful data object (column 5, lines 43-60).

Regarding claim 22, Souissi teaches the step of determining whether the mobile station has registered in one of the selected communication networks is performed by a determination device (home network) assigned to the mobile station or the switching component (column 5, lines 32-42).

Regarding claim 23, Souissi teaches the determination device notifies the mobile station that the mobile station has registered in one of the selected communication networks, when it is determined either by the switching component or by the assigned communication device that the mobile station has registered in one of the selected communication networks (column 9, lines 33-57; registration acknowledgement).

Regarding claim 24, Souissi teaches the mobile station sends the switching component the delivery request for the useful data object, either when it is determined by the mobile station that the mobile station has registered in one of the selected communication networks, or the mobile station is notified by the determination device assigned to the switching component that the mobile station has registered in one of the selected communication networks (column 7, lines 58-67; column 8, lines 1-3).

Regarding claim 25, Souissi teaches the switching component transmits the useful data object to the mobile station when the delivery request for the useful data object is sent from the mobile station to the switching component or the switching component already has a delivery request (column 7, lines 58-67; column 8, lines 1-3).

Regarding claim 26, Souissi teaches the useful data object is transmitted as a multimedia message in the context of the multimedia messaging service between the switching component and the mobile station (column 3, lines 39-42).

Regarding claim 27, Souissi teaches the mobile station displays to a user, on receipt of a notification that a useful data object is available, the option of selecting from at least two of the following options: transmitting the useful data object from the switching component immediately, at a later time or after registration of the mobile station in the home network or in a previously selected network outside the home network (column 7, lines 16-24; user is capable of obtaining the complete message immediately or elects to obtain it later).

Regarding claim 28, Souissi teaches the useful data object is sent from a data provision component to the switching component for transmission to the mobile station (column 4, lines 48-64).

Regarding claim 29, Souissi teaches at least one of the following information items contained in the useful data object is stored in a storage unit assigned to the mobile station: a status of the transmission process of the useful data object, the at least one selected communication network, a selected parameter(s), notification and messages, information specific the useful data object (column 4, lines 48-55).

Regarding claim 31, Souissi teaches the storage, the receiving and sending of the useful data object, the selection of the communication network, the selection of the parameters and/or the display on the mobile station are executed by a software application on the mobile station (column 7, lines 15-24).

Regarding claim 32, the limitations are rejected as applied to claim 18.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Souissi et al. (US 7,392,039) in view of Molne (US 6,014,561).

Souissi teaches that the home network stores information regarding networks for which the communication device may receive messages on, but does not explicitly teach that this information is stored on a SIM card or a UICC card with a USIM application. Molne discloses a method and apparatus for over the air activation of a multiple mode/band radio telephone (abstract). Molne teaches that the SIM card stores information for operation of a handset on two different networks (column 8, lines 14-32). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Souissi to allow network information for which the device may communicate with on the SIM, as taught by Molne, in order to

alternatively store network information on the SIM card thus providing the capability to provision the device over the air. Furthermore a skilled artisan would recognize that storage of the information on the network and SIM is interchangeable.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 18, 19, and 21-32 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617

/Nam Huynh/  
Examiner, Art Unit 2617